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MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

EXAMINER	
ANDERSON, JAMES D	
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAYMOND J. BERGERON

Appeal 2009-015146
Application 10/091,591
Technology Center 1600

Before DONALD E. ADAMS, DEMETRA J. MILLS, and ERIC GRIMES, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

This appeal under 35 U.S.C. § 134 involves claims 1-6, the only claims pending in this application. The claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Frydman[2] and the written description provision of 35 U.S.C. § 112, first paragraph.

We have jurisdiction under 35 U.S.C. § 6(b).

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

[2] Frydman et al., US 5,889,061, issued March 30, 1999.

Obviousness:

ISSUE

Does the preponderance of evidence support a conclusion that Frydman suggests an effective amount that falls within the scope of Appellant's claimed invention?

FINDINGS OF FACT

FF 1. The Examiner finds and Appellant does not dispute that Frydman suggests a compound within the scope of the claimed invention (Ans. 6).

FF 2. Appellant's Specification discloses that "a suitable dose of agent will lie in the range of about .0001 mg to about 500 mg per kilogram of mammal body weight being treated" (Spec. 10: 1-3).

FF 3. The Examiner finds and Appellant does not dispute that Frydman suggests administering a dosage of a compound effective "to provide a concentration of drug at a point of contact with the cancer cell of from 1 μM to . . . 100 μM" (Ans. 14).

FF 4. The Examiner finds that a compound administered within Frydman's concentration range "will contain 'an effective amount' ranging from about 0.0001 to about 500 mg per kilogram of mammal body weight being treated" (*id.*).

ANALYSIS

The claims are not separately argued and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Claim 1 is representative and is reproduced in the "APPENDIX OF CLAIMS ON APPEAL" of Appellant's Brief (App. Br. A-i).

Appellant contends that "the limitation in the body of the claims that the composition contain 'an amount effective' to produce an 'anti-diarrheal

or gastrointestinal anti-spasmodic' action is a positive structural feature of the claim that cannot simply be ignored by the Examiner" (Reply Br. 8; *see generally* App. Br. 6-9). We are not persuaded.

Claim 1 is drawn to a composition. Claim 1 structurally defines the composition as comprising (a) a compound having the recited formula save two specific compounds and (b) a pharmaceutically acceptable carrier. Claim 1 defines the use or purpose of that structure as an anti-diarrheal or gastrointestinal anti-spasmodic pharmaceutical. "[T]he patentability of . . . composition claims depends on the claimed structure, not on the use or purpose of that structure." *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002).

There is no dispute on this record that Frydman suggests a compound encompassed by the formula of claim 1 (FF 1). Instead, the dispute focuses on whether Frydman suggests an effective amount that falls within the scope of Appellant's claimed invention. In this regard, Appellant contends that the Examiner has the "burden of unequivocally establishing that the ranges overlap" and until the Examiner fulfills this burden Appellant has no obligation to rebut the Examiner's conclusion of obviousness (Reply Br. 10). We are not persuaded.

The PTO has the initial burden of providing a rationale to show that the product described by the prior art is the same product that is claimed. *In re Marosi*, 710 F.2d 799, 802 (Fed. Cir. 1983). Once a prima facie case has been established, the burden shifts to Appellant "to prove that the prior art products do not necessarily or inherently possess the characteristics of the claimed product." *In re Fitzgerald*, 619 F.2d 67, 70 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977).

On this record, the Examiner reasons that in order to obtain a concentration of 1 μM to 100 μM at the location of a cancer cell in a mammalian body, as disclosed by Frydman, the systemically administered dose of the composition must be in the range of from about 0.1 μg to about 500 mg per kilogram of mammal body weight being treated (FF 4; *see also* FF 2-3). In our opinion the Examiner's rationale properly shifted the burden to Appellant to establish that Frydman fails to suggest the administration of an amount ranging from about 0.1 μg to about 500 mg per kilogram of mammal body weight being treated. Appellant failed to carry this burden. Accordingly, the preponderance of evidence falls in favor of the Examiner.

CONCLUSION OF LAW

The preponderance of evidence supports a conclusion that Frydman suggests an effective amount that falls within the scope of Appellant's claimed invention. The rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Frydman is affirmed. Claims 2-6 fall together with claim 1.

Written Description:

Having sustained a rejection of all claims on this record we do not reach the merits of the written description rejections before us on this Appeal.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

alw

MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833